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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/071,032  | 02/08/2002  | Richard Dennis Dyer  | A0000425-01-CFP     | 3659             |
| 28880   | 7590        | 01/21/2004           | EXAMINER            |                  |
| WARNER-LAMBERT COMPANY<br>2800 PLYMOUTH RD<br>ANN ARBOR, MI 48105 |             |                      | TRUONG, TAMTHOM NGO |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 1624                 |                     |                  |

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 10/071,032             | DYER ET AL.         |
| Examiner                     | Art Unit               |                     |
| Tamthom N. Truong            | 1624                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.  
2a)  This action is **FINAL**.                            2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-44 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) \_\_\_\_\_ is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) 1-44 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 (in part), 7-32 (in part), and 34-44 (in part), drawn to compounds of formulae I, II, III, V, VI, VII, and VIII, wherein **X** is **S**, **SO**, or **SO<sub>2</sub>**, also their pharmaceutical composition and methods of treatment; classified in classes 514, subclass 259.2, and class 544, subclass 278.
- II. Claims 1, 2, 5, 6, 8-10, 21-31, 33, and 36-44 (part of each), drawn to compounds of formulae I, IV, VI, and VII, wherein **X** is **O**, also their pharmaceutical composition and methods of treatment, classified in class 514, subclass 259.2, and class 544, subclass 278.
- III. Claims 1, 2, 8-10, 21-31, and 36-44 (part of each), drawn to compounds of formulae I, VI, and VII, wherein **X** is **CH<sub>2</sub>**, **C=O**, or **CHOH**, also their pharmaceutical composition and methods of treatment, classified in class 514, subclass 259.5, and class 544, subclass 282.
- IV. Claims 1, 2, 8-10, 21-31, and 35-44 (part of each), drawn to compounds of formulae I, IV, VI, and VII, wherein **X** is **NH** or **NR<sup>5</sup>**, also their pharmaceutical composition and methods of treatment, classified in class 514, subclasses 259.5, 265.1, and class 544, subclass 281.

The inventions are distinct, each from the other because of the following reasons:

A. Although the four groups belong to the same class, each group is drawn to a distinct bicyclic system. These four bicyclic systems are not equivalent of each other as evident by the teachings of **Naka et. al.** (US 5,082,838), and **Shiokawa et. al.** (US 5,622,956). Also, each group of compound has different chemical and physical properties which set them apart. For example, according to Naka et. al., the compounds in group I can treat immune diseases or inflammatory diseases. However, according to Shiokawa et. al., the compounds of group III have insecticidal activity which is useful in agricultural uses rather than pharmaceutical uses. Such a divergence in utility renders the invention of each group independent and unrelated to each other.

B. The common core of a fused dioxo (or dithio)-pyrimidine ring does not sufficiently define the bicycle of the invention. Thus, depending what X is, the bicycle for each group would be patentably distinct from each other. Therefore, the search for one group would not yield references that could anticipate or render obvious the other groups. Furthermore, a search on the fused dioxo (or dithio)-pyrimidine ring alone would yield a large volume of hits. Such a search would result in missing relevant prior arts. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A voice message was left for Mr. Claude Purchase on 01-13-04 regarding the above restriction requirement. However, no response has been received from Mr. Purchase.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9 am - 5:30 pm) starting from January 12<sup>th</sup>, 2004.

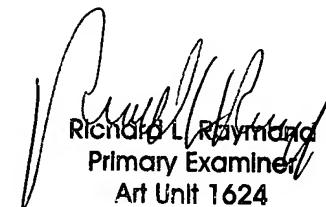
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
T. Truong

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January 19, 2004

  
Richard L. Raymond  
Primary Examiner  
Art Unit 1624